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10/773,237

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EXAMINER

LONG, FONYA M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/773,237	Applicant(s) IKEDA ET AL.	
	Examiner FONYA LONG	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-10, 12-16, 18, 19, 27-29, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 11, 17, 20-26, 30-35 and 38-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-10, 12-16, 18, 19, 27-29, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/05/2004; 12/31/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This communication is a first Non-Final Office Action rejection on the merits in response to communications received on May 18, 2009. Claims 4-10, 12-16, 18, 19, 27-29, 36, and 37 are currently pending and have been addressed below.

Election/Restrictions

1. Claims 1-3, 11, 17, 20-26, 30-35, and 38-51 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 18, 2009.

Specification

2. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

- a. Page 4, via "...materials after the agreement is concluded, **etc. amass a huge volume.**"
- b. Page 15, via "...the renewal or the automatic termination of an agreement to be **coped with.**"

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- c. Examiner asserts that the written description contains numerous spacing errors wherein the words are not separated with a space such as Page 64, Lines 1-2, via "....an other agreement ***conditionswhendownloadingagreementdata***."

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4-10, 12-16, 18, 19, 27-29, 36, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claims 4-10, 12-16, 18, 19, 27-29, 36, and 37, the claims recite structure which is not provided in the written description. The claims recite the structures such as "an agreement data registering unit; a balance data registering unit; a relevant division registering unit; a notifying unit; an adding/registering unit; and a registration screen switching unit". It is unclear what a unit is comprised of. Is the unit a computer? Is the unit software being performed by a computer?

As per Claims 4 and 12, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

As per Claims 4, 9, 10, 12, 15, and 27, the phrase "etc." renders the claim indefinite it is unclear what limitations are included or excluded from the claimed

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invention. The term "etc." is interpreted to including anything and therefore fails to particularly point out and distinctly claim the subject matter.

As per Claims 9 and 16, the claim recites calculating a running royalty balance. However, the claim and the written description fail to recite how the calculation is performed. It is unclear what elements or variables are used to perform the calculation.

As per Claim 10, the claim recites processing a statistical balance of a running royalty. However, the claim and the written description fail to recite how a statistical balance is determined. What variables are used to determine a statistical balance?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-10, 12-16, 18, 19, 27-29, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harnes et al. (US 2004/0085355) in view of Rivette et al. (US 2007/0208669).

As per Claim 4, Harnes et al. discloses an agreement management system (Abstract, via contract management system), comprising:

an agreement data registering unit classifying information about an agreement as any of basic information such as party data, etc., an agreement target, agreement conditions such as a consideration, etc., and balance data of a running royalty, etc.,

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each of which is regarded as a data registration unit, regarding each data item of the basic information, the agreement target, and the agreement conditions as a group, and registering the group as agreement data ([0045-0046]; Claims 27-28, discloses classifying information pertaining to a contract (i.e. agreement)); and

the agreement data are stored in an agreement database by said agreement data registering unit (Claim 1, discloses a database storing electronic contract documents (i.e. agreement data) wherein each electronic contract document associated with a contract category of a plurality of contract categories).

However, Harmes et al. fails to explicitly disclose a balance data registering unit and storing balance data.

Rivette et al. discloses managing license agreements with the concept of a balance data registering unit registering the balance data ([2333] via report tracks the payment amount allocated to a license agreement and compares it to the expected revenue amount providing a balance due); and the balance data are stored in an agreement database by said balance data registering unit (Fig. 286A-286C; [2332] via balance due (i.e. balance data) being stored in a database).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a balance data registering unit and storing balance data as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 5, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a unit processing data of a money amount.

Rivette et al. discloses managing license agreements with the concept of a unit processing data of a money amount, which is handled as balance data incurred by an agreement, is processed in a currency unit of a money amount of an income of an expenditure, adding an exchange rate, and registering the money amount (Fig. 265; [281] via entering revenue received from the sale (i.e. money amount) and the currency unit for the revenue, wherein the royalty due is determined based on the information provided).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit processing data of a money amount as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 6, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose registering data distributed to or shared by a third party.

Rivette et al. discloses managing license agreements with the concept of said balance data registering unit has a function for registering data distributed to or shared by a third party other than agreement parties for data of an income or payment money amount ([2160-2180] via inputting payment amount the licensee sends to the licensor

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wherein the License Administrator (i.e. third party) is provided with the payment information).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include registering data distributed to or shared by a third party as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 7, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a relevant division registering unit registering data of an income or an expenditure stipulated by a consideration condition.

Rivette et al. discloses managing license agreements with the concept of a relevant division registering unit registering data of an income or an expenditure stipulated by a consideration condition, which is one item of agreement information as distribution information or sharing information among relevant divisions within a company ([2157-2180] discloses registering a payment (i.e. an amount of money the licensee sends to the licensor based on the amount they owe for fees, royalties, advances, minimum guarantees, and other compensation terms) within the system).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a relevant division registering unit registering data of an income or an expenditure stipulated by a consideration condition

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as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 8, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a unit extracting an income amount or and expenditure amount from the balance data relevant to the agreement.

Rivette et al. discloses managing license agreements with the concept of a unit extracting an income amount or and expenditure amount from the balance data relevant to the agreement, and respectively aggregating and outputting an income amount and an expenditure amount for a running royalty balance of one or more agreements selected with specification in a predetermined term ([2332; 2340] via generating reports from the information contained in the databases. IP Asset-Historical Royalties report lists the agreements that license out the asset and provides a running total of royalties earned (i.e. running royalty balance)).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit extracting an income amount or and expenditure amount from the balance data relevant to the agreement as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 9, Harmes et al. discloses the claimed invention as applied to Claim 6, above. However, Harmes et al. fails to explicitly disclose a unit calculating and outputting a running royalty balance.

Rivette et al. discloses managing license agreements with the concept of a unit calculating and outputting a running royalty balance including income distribution or expenditure sharing, when balance data of a running royalty, etc. of one or more agreements is statistically processed ([2332; 2340] via generating reports from the information contained in the databases. IP Asset-Historical Royalties report lists the agreements that license out the asset and provides a running total of royalties earned (i.e. running royalty balance)).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit calculating and outputting a running royalty balance as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 10, Harmes et al. discloses the claimed invention as applied to Claim 7, above. However, Harmes et al. fails to explicitly disclose a unit processing a statistical balance of a running royalty.

Rivette et al. discloses managing license agreements with the concept of a unit processing a statistical balance of a running royalty etc. from registered agreement information for each division involved in agreement information (Fig. 293A & B,

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discloses processing a running royalty balance for each company involved in the agreement information).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit processing a statistical balance of a running royalty as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 12, Harmes et al. discloses a notifying unit notifying a user of every deadline such as agreement expiry date, an update deadline, an implementation report deadline, an installment payment due date, etc., at a predetermined time point (Fig. 9; [0021; 0050; 0056] via the system sending e-mail reminders of the dates upon events such as contract renewal or performance deadlines occur).

As per Claim 13, Harmes et al. discloses said notifying unit makes a notification to a responsible division via e-mail (Fig. 9; [0021; 0050; 0056] via the system sending e-mail reminders).

As per Claim 14, Harmes et al. discloses a unit registering presence/absence and abortion/resume of an implementation report registered in accompaniment with a consideration condition, which is part of agreement information ([0034] discloses a user being capable of editing stored documents, delete documents, and add documents. The forms contracts file registers the edited, deleted, and added documents via tracking and archiving versions of the documents.).

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As per Claim 15, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a unit registering agent information and its expense.

Rivette et al. discloses managing license agreements with the concept of a unit registering agent information and its expense, etc. as one item of information about an agreement (Fig. 292B, discloses registering company information and its revenue as a line item about an agreement).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit registering agent information and its expense as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 16, Harmes et al. discloses the claimed invention as applied to Claim 15, above. However, Harmes et al. fails to explicitly disclose a unit calculating balance data.

Rivette et al. discloses managing license agreements with the concept of a unit calculating balance data by adding the expense in a balance data statistical process (Fig. 286A1 & 286A2, discloses calculating a balance amount).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit calculating balance data as

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taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 18, Harmes et al. discloses a unit searching for corresponding agreement data by selecting a predetermined item from among data of various registered agreements, and outputting searched data ([0021] via user can store and view different version of contracts and search the text of documents for words and phrases).

As per Claim 19, Harmes et al. discloses a unit searching for a data portion input as a document (text) in a traverse manner among agreement data and balance data ([0021] via user can store and view different version of contracts and search the text of documents for words and phrases).

As per Claim 27, Harmes et al. discloses an adding/registering unit adding an additional number (version number) to a management number of a agreement data if an additional arrangement by an addition or modification is made to agreement conditions, etc. of the registered agreement data, and registering the agreement data (Fig. 7; [0043] discloses providing a version number in reference to a contract (i.e. agreement) that has been modified).

As per Claim 28, Harmes et al. discloses said adding/registering unit makes an addition/modification based on the agreement data, and records and manages information differing from original agreement data ([0034] via user can edit stored documents, delete documents, and add documents. The form contract file can be used to track and archive versions of the organization's form contracts.).

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As per Claim 29, Harmes et al. discloses a registration screen switching unit registering a plurality of items of data by switching a screen depending on an agreement target and an agreement condition ([0045-0046]; Claims 27-28, discloses classifying information pertaining to a contract (i.e. agreement)).

As per Claim 36, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a unit extracting an agreement whose implementation report is to be made from individual registered agreements.

Rivette et al. discloses managing license agreements with the concept of a unit extracting an agreement whose implementation report is to be made from individual registered agreements, and displaying the extracted agreement along with a report deadline ([2342] via generating an intellectual property license summary report that provides a summary of agreements for each licensee).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit extracting an agreement whose implementation report is to be made from individual registered agreements as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

As per Claim 37, Harmes et al. discloses the claimed invention as applied to Claim 4, above. However, Harmes et al. fails to explicitly disclose a unit displaying or printing a bill.

Rivette et al. discloses managing license agreements with the concept of a unit displaying or printing a bill in a predetermined format based on data selected from among registered balance data (Fig. 292A & B, via providing a royalty statement providing the royalty due (i.e. bill)).

Therefore, from the teaching of Rivette et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the contract management system of Harmes et al. to include a unit displaying or printing a bill as taught by Rivette et al. in order to aid in managing license agreements and royalty revenues resulting from the license agreements.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schrader et al. (5,903,881) discloses a personal online banking system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thurs. 7:30am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689